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09/974,022	10/10/2001	Steven P. Bibeault	17549-105	7517

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BOSTON, MA 02111

EXAMINER

SNIDER, THERESA T

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 06/04/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/974,022

Applicant(s)

BIBEAULT ET AL.

Examiner

Theresa T. Snider

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20, drawn to a cleaning system, classified in class 15, subclass 301.
  - II. Claims 21-22, drawn to method of cleaning residual material from a needle, classified in class 134, subclass 21.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another apparatus such as one without a control system as claimed.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Thomas Sullivan (and Ex. El Arini) on 4/14/2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-22 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Drawings*

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "90" has been used to designate both disposable contain(page 9, line 7) and disposable cup(page 9, line 10). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

7. The abstract of the disclosure is objected to because of the inclusion of legal phraseology; line 7, 'control means'. Correction is required. See MPEP § 608.01(b).

8. The disclosure is objected to because of the following informalities:

Exemplary of such:

Page 1, line 31, it is unclear as to what is meant by 'small an amount'.

Appropriate correction is required.

### *Claim Objections*

9. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. Claim 2 fails to further structurally limit the apparatus but rather defines a function of use.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Exemplary of such:

✓ Claims 1, 8, 13 and 20, it is unclear as to whether the 'an airflow' is for suctioning or blowing.

✓ Claim 1, line 6, 'the liquid' should be replaced with 'a liquid'.

✓ Claim 4, line 2, 'the disposable cup' lacks proper antecedent basis.

Claim 12, line 3, is the needle or pin present?

→ Claim 13, line 6, 'the liquid dispensing needle lacks proper antecedent basis.

✓ Claim 14, line 1, 'the means for operatively positioning' lacks proper antecedent basis.

✓ Claim 15, line 5, it is unclear as to whether the 'a vacuum source' is in addition to that of line 3 or one in the same.

✓ Claim 17, line 2, it is unclear as to whether 'a dispensing needle or pin' is in addition to that of claim 15, line 2 or one in the same.

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✓ Claim 20, line 2, it is unclear as to whether the 'at least one vacuum source' is in addition to that of claim 15, line 3 or one in the same;

✓ line 2, 'the' should be inserted after 'with';

✓ Line 3, it is unclear as to whether 'an orifice' is in addition to that of claim 17, line 2 or one in the same.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-2, 4 and 12-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Blattner.

Blattner discloses a container assembly having at least one orifice (fig. 6, #54).

Blattner discloses a vacuum source operatively connected to the container assembly (fig. 6, #58).

Blattner discloses a control system that positions a liquid dispensing needle relative to the container (col. 3, lines 51-60 and col. 4, lines 46-56).

With respect to claim 2, Blattner discloses removing residual material from the needle without contacting the needle (col. 4, lines 45-56).

With respect to claim 4, Blattner discloses the container assembly including a tube (figs. 1 and 6, #52).

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With respect to claim 12, Blattner discloses a means for receiving a liquid from a liquid source (fig. 2, #40). Blattner discloses a means for dispensing a liquid through a needle onto a medium (col. 5, lines 47-50 and 57-61). Blattner discloses a means for removing residual material from an exterior portion of the needle (col. 6, lines 6-22 and col. 7, lines 10-15).

With respect to claim 13, Blattner discloses a container assembly having at least one orifice (fig. 6, #54). Blattner discloses a vacuum source connected to the container assembly (fig. 6, #58).

With respect to claims 13-15, Blattner discloses a computer control system for operatively positioning the need relative to the at least one orifice (col. 3, lines 51-60 and col. 4, lines 46-65).

With respect to claims 16-17, Blattner discloses at least one container assembly having at least one orifice (fig. 6, #54).

With respect to claim 20, Blattner discloses a vacuum source coupled to the container assembly (fig. 6, #58).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopes in view of Cavallaro.

Lopes discloses a similar system however fails to disclose the nozzle being a needle or pin.

Lopes discloses a means for receiving a liquid from a liquid source (fig. 1, #12A-B).

Lopes discloses a means for dispensing liquid through a nozzle onto a medium (fig. 1, #14,17). Cavallaro discloses that it is known in the art to use a needle or pin as a nozzle for dispensing a material onto a medium (col. 3, lines 58-60). It would have been obvious to one of



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ordinary skill in the art to provide the needle of Cavallaro in Lopes to allow for the dispensing of liquid in a desired pattern.

Lopes discloses a means for removing an amount of residual material from an exterior of the nozzle without contacting the nozzle (col. 7, lines 16-30).

18. Claims 5-6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blattner.

Blattner discloses a similar device however fails to disclose a plurality of orifices.

It would have been obvious to one of ordinary skill in the art to provide for a plurality of orifices in the container assembly of Blattner to allow for removal of different reagents in different locations to allow for proper disposal thereof.

*Allowable Subject Matter*

19. Claim 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

20. Claims 3, 7, 9-11 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

21. The following is a statement of reasons for the indication of allowable subject matter: The prior art discloses a cleaning system for removing residual material from a needle having a container assembly with at least one orifice, a vacuum source operatively connected to the container assembly and a control system that positions a liquid dispensing needle relative to the

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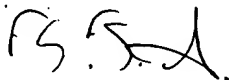
Container HOWEVER fails to disclose or fairly suggest the container assembly having a disposable cup OR an iris-type shutter having a variable diameter opening OR the orifice having an adjustable diameter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa T. Snider whose telephone number is (703) 305-0554. The examiner can normally be reached on Monday-Wednesday (6:30AM-3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 879-9310 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Theresa T. Snider  
Examiner  
Art Unit 1744



TTS  
June 2, 2003